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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,767	02/15/2001	Carl Saieva	1180-6 (A)	2272

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Thomas M. Galgano, Esq.
Galgano & Burke
Suite 135
300 Rabro Drive
Hauppauge, NY 11788

EXAMINER

TRUONG, BAO Q

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,767

Applicant(s)

SAIEVA, CARL

Examiner

Bao Q. Truong

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-15 is/are rejected.
- 7) ☒ Claim(s) 3 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 25 November 2002 have been approved.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "heat sink means" in claims 1 and 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: amended specification page 2, the reference numbers 13 and 21 on lines 5 and 9 respectively.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Acks et al. [US 5,105,346].

Regarding claims 1 and 8, Acks et al. disclose a high-intensity underwater light [2] having a high intensity arc lamp [4] containing a hermetically sealed glass envelope with a mixture of ionizable elements, a sealed ballast container containing an electronic ballast [24] with an input [26] and an output [22], a cathode and an anode in the arc lamp [4], which are connected to the output [22] of the ballast [24], a coupling means [37] connected to a DC power source, and a heat sink means [stainless steel] for dissipating heat from the ballast (figures 1- 5, column 2 lines 25-68, column 3 lines 1- 68).

Regarding claims 2 and 9, Acks et al. disclose a waterproof protective container [10] covering the envelope of the arc lamp [4] having a transparent window (figure 2 column 2 line 67).

Regarding claims 4 and 11, Acks et al. disclose an underwater matable connector [31, 37] (figure 1, column 3 lines 43-55).

Regarding claims 5 and 12, Acks et al. disclose the coupling means [22, 26, 31, 37] with a pair of connectors inside for electrical power supply to the ballast [24] and the arc lamp [4] (figures 1 and 5).

Regarding claim 15, Acks et al. disclose a ballast container being mounted with 15 inches of the arc lamp [4] (figures 1 and 5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acks et al. as applied to claims 1 and 8 above.

Regarding claims 6, 7, 13 and 14, Acks et al. disclose a ballast container being made of stainless steel serving as a heat sink means (column 3 lines 43-49).

Acks et al. do not disclose the ballast container being potted of a thermally conductive epoxy serving as the heat sink means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use epoxy material to replace the Aluminum alloy of Mula for the ballast container, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a mater of obvious design choice, *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

8. Claims 3 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter of claims 3 and 10. An underwater lighting system further comprises a waterproof protective container having a transparent window and covering the envelope of the discharge lamp and the electronic ballast.

The limitations discussed above are neither disclosed nor suggested by the prior art of records.

Response to Arguments

9. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (703) 308-6452. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.


Stephen Husar
Primary Examiner

Bao Q. Truong
Examiner
Art Unit 2875

BQT
February 6, 2003